

**REMARKS**

The Office Action indicates that claims 1-8 and 17-22 are allowed and that claims 10-16, while objected to as being dependent from a rejected base claim, would be allowable if rewritten in independent form. However, independent claim 9 stands rejected under 35 U.S.C. § 102(b) as being anticipated by the allegedly “admitted prior art.” Applicant respectfully traverses this rejection of independent claim 9 for at least the following reasons.

With regard to the rejection of claim 9 under 35 U.S.C. § 102, the Office Action refers to Figs. 1 and 2B of the “Description of the Related Art” section of the instant application’s specification as prior art against claim 9 of the instant application.

Applicants respectfully submit that Fig. 2B of the instant application illustrates a single focus error signal FE (solid line), in which the focus error level (vertical axis) is changed as the focusing position is changed in the depth direction of the recording medium (horizontal axis). Applicants note that Fig. 2B is drawn such that the focusing position is normalized by the capture range (i.e., “DEFOCUS AMOUNT / CAPTURE RANGE”) for a certain (fixed) capture range. More particularly, Fig. 2 B shows a single “composite focus error signal FE (solid line)” which is a combined signal of error components or contributions (three dashed lines) from the three recording layers, when the capture range is  $\frac{1}{4}$  of the layer interval or the capture range is not sufficiently smaller than the layer intervals. As a result, Applicants respectfully submit that Fig 2B does not teach, or even suggest, at least “a plurality of focus error signals” or different capturing ranges in the manner recited in independent claim 9. See, for example, page 3, lines 14-20 of the instant application’s specification.

Applicants note, in contrast with Fig. 2B, Fig. 2A shows a focus error signal FE having little interference between the error components where the capture range is sufficiently smaller

(1/10 of the layer interval) than the layer intervals. See, for example, page 3, lines 6-14 of the instant application's specification. However, as discussed at least at page 4, lines 1-4 of the instant application's specification, "a reduction in the capture range makes the focus pull-in difficult, and a disturbance such as vibration during recording/reproducing operation easily interrupts the focus servo control." As a result, in order to overcome this problem, Applicants respectfully submit that embodiments of the optical pickup apparatus of the present application are provided with "a focus error signal generation portion for generating a plurality of focus error signals each having a capture range, said capture ranges being different from one another" as is recited in independent claim 9.

At page 2 of the Office Action, the Examiner states that "[c]laim 9 merely read on generating a first focusing error signal ... in a multi layer disk." However, Applicants respectfully submit that the specific arrangements of embodiments of the instant application, such as the combination recited in independent claim 9, is neither taught nor suggested by the cited references for at least the foregoing reasons.

Accordingly, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because the allegedly "admitted prior art" does not teach or suggest each feature of independent claim 9. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Furthermore, while the Examiner is thanked for the indication that dependent claims 10-16, while objected to as being dependent upon a rejected base claim, would be allowable if rewritten in independent form, Applicants respectfully assert that these

dependent claims 2-8 are also allowable at least because of the dependence from independent claim 9, and the reasons set forth above. Accordingly, withdrawal of the objection of claims 10-16 is respectfully requested.

### **CONCLUSION**

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application, withdrawal of all rejections, and the timely allowance of all pending claims .

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite the prosecution.


**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

**MORGAN, LEWIS & BOCKIUS LLP**

Dated: February 8, 2005

By:

  
Paul A. Fournier  
Reg. No. 41,023

**MORGAN, LEWIS & BOCKIUS LLP**

1111 Pennsylvania Avenue, N.W.

Washington, D.C. 20004

Tel: 202-739-3000

Fax: 202-739-3001